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| 10/726,800 | 12/02/2003 | Jan Steenkamp | 5782P028 | 4122 |
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| Andre L. Marais Schwegman, Lundberg, Woessner & Kluth, P.A. 1600 TCF Tower 121 South Eighth Street Minneapolis, MN 55402 | | | EXAMINER CHAE, KYU | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/726,800

Applicant(s)

STEENKAMP ET AL.

Examiner

KYU CHAE

Art Unit

2426

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 07/30/2004, 09/02/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claim 16** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 16 is drawn to functional descriptive material encoded on a machine-readable medium. The specification (see ¶ 0490) defines the claimed machine-readable medium as encompassing statutory media such as solid state memory, disks, or tapes, etc; however, the specification does not exclude non-statutory subject matter such carrier waves, infrared signals, and other forms of propagated signals. A signal embodying functional descriptive material is neither a process, nor a computer, nor a manufacture, nor a composition of matter (i.e., a tangible thing) and therefore does not fall within one of the four statutory classes of § 101. Rather, signals are a form of energy absent of any physical structure or tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory, under the present USPTO Interim Guidelines, 1300 Official Gazette Patent and Trademark Office 142 (Nov. 22, 2005).

The Examiner suggests amending the claim to include the disclosed tangible computer-readable media, while at the same time excluding the intangible media such as signals, carrier waves, etc.

Any amendment to the claim should be commensurate with its corresponding disclosure.

In order to expedite the prosecution of the instant application, the Examiner will reject claim 28 under (§102 or §103) as if the claims were directed to a proper statutory class.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-10, 13-18, 20 and 21** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S Patent No. 7,139,983 B2 to *Kelts*.

As to **claim 1**, *Kelts* discloses a method to provide digital content to a content destination (Fig. 8, abstract), the method comprising:

providing a plurality content provider identifiers to the content destination for display on an a display device, wherein each content provider identifier is associated with a content provider (Fig. 1 col. 4, ll. 1-6 & col. 19, ll. 1-4, navigational interface featuring a set of symbols or icons representing service providers and broadcasting networks);

monitoring user selection of one of the plurality of content provider identifiers (col. 22, ll. 7-11, presentation layer and navigation interface display within an end user's control can be monitored indirectly by a web browser application); and

communicating at least one available content identifier to the content destination in response to the user selection of a content provider identifier , the available content identifier being associated with the content provider identifier (Fig. 1 col. 4, ll. 1-6, & col. 10, ll. 27-32, e.g. user can highlight a content provider identifier and a select button to view this channel).

As to **claim 2**, *Kelts* discloses the method of claim 1, wherein each content provider identifier is associated with a plurality of available content identifiers arranged in a hierarchical fashion (Fig. 1 col. 12, ll. 1-7 & col. 13, ll. 5-8).

As to **claim 3**, *Kelts* discloses the method of claim 2, wherein at least one available content identifier relates to digital content that is selectively rendered to the content destination upon selection of the at least one available content identifier (Fig. 1 col. 4, ll. 1-6, col. 10, ll. 27-32 & col. 16, ll. 51-59).

As to **claim 4**, *Kelts* discloses the method of claim 2, wherein at least one available content identifier relates to a group of digital content, the group including at least one further available content identifier that identifies digital content that is available for communication to the media terminal upon selection of the at least one further available content identifier (Fig. 2, col. 12, ll. 22-30, ll. 64 - col. 13, ll. 5, level of magnification increases the level of detail on the navigation element e.g. zooming allows the display of lower order subcategories)

As to **claim 5**, *Kelts* discloses the method of claim 2, wherein each content provider identifier has an associated link that links the content destination to the content provider upon selection of the content provider identifier, the content provider providing the at least one available content identifier to the user (Fig. 1, col. 10, ll. 27-32).

As to **claim 6**, *Kelts* discloses the method of claim 2, wherein the content destination communicates an HTML request associated with the available content identifier (col. 26, ll. 52-57 & col. 26, ll. 67 - col. 27, ll. 4).

As to **claim 7**, *Kelts* discloses the method of claim 1, which comprises selectively communicating digital content associated with an available content identifier to the content destination independently of the content distributor (col. 28, ll. 9-15, filters may reduce the number of selection items or otherwise modify the navigation interface data retrieved by the system).

As to **claim 8**, *Kelts* discloses the method of claim 1, wherein the content provider identifiers are included in a communication between a content distributor and the content destination (Fig. 8, col. 25, ll. 40-46 & col. 26, ll. 52-57).

As to **claim 9**, *Kelts* discloses the method of claim 1, wherein the content provider identifiers are icons that visually identify an associated content provider (Fig. 1, col. 4, ll. 1-6).

As to **claim 10**, *Kelts* discloses the method of claim 1, which comprises selectively communicating digital content associated with an available content identifier via a cable head-end of a cable network to the content destination (Fig. 8, col. 25, ll. 40-52).

As to **claim 13**, *Kelts* discloses the method of claim 1, which comprises communicating the user selection to a digital rights network (Fig. 6, col. 19, ll. 57-59, security information).

As to **claim 14**, *Kelts* discloses a method to provide digital content on a media terminal (Fig. 8, abstract), the method including:

receiving a plurality of content provider identifiers via a content distribution network, each content provider identifier being to identify an associated content provider (Fig. 1 col. 4, ll. 1-6 & col. 19, ll. 1-4, navigational interface featuring a set of symbols or icons representing service providers and broadcasting networks);

generating a graphic user interface to display the content provider identifiers to a user on a display device (Fig. 1, col. 4, ll. 1-6, content provider identifiers on navigation interface);

monitoring selection of one of the plurality of content provider identifiers by a user (col. 22, ll. 7-11, presentation layer and navigation interface display within an end user's control can be monitored indirectly by a web browser application);

communicating a request associated with the a selected content provider (Fig. 1 col. 4, ll. 1-6, & col. 10, ll. 27-32, e.g. user can highlight a content provider identifier and a select button to view this channel);

receiving at least one available content identifier that identifies digital content available from the content provider (Fig. 1 col. 4, ll. 1-6, & col. 10, ll. 27-32);

generating a graphic user interface to display the available content identifiers to the user on the display device (Fig. 2, col. 4, ll. 1-6, col. 10, ll. 27-32 & col. 16, ll. 51-59).

As to **claim 15**, *Kelts* discloses the method of claim 14, which comprises; monitoring selection of an available content identifier by the user (col. 22, ll. 7-11); and

communicating an HTML request associated with an available content identifier to a content provider (col. 26, ll. 52-57 & col. 26, ll. 67 - col. 27, ll. 4).

As to **claim 16**, *Kelts* discloses a machine-readable medium for storing a set of instructions that, when executed by a machine (col. 18, ll. 19-38), cause the machine to:

provide a plurality content provider identifiers to a content destination for display on a display device, wherein each content provider identifier is associated with a content provider (Fig. 1 col. 4, ll. 1-6 & col. 19, ll. 1-4, navigational interface featuring a set of symbols or icons representing service providers and broadcasting networks);

monitor user selection of one of the plurality of content provider identifiers (col. 22, ll. 7-11, presentation layer and navigation interface display within an end user's control can be monitored indirectly by a web browser application); and

communicate at least one available content identifier to the content destination in response to the user selection of a content provider identifier, the available content identifier being associated with the content provider identifier (Fig. 1 col. 4, ll. 1-6, & col. 10, ll. 27-32, e.g. user can highlight a content provider identifier and a select button to view this channel).

As to **claim 17**, see claim 1 for similar rejection where the system is taught by the method.

As to **claim 18**, *Kelts* discloses the system of claim 17, wherein the plurality of content providers communicate digital content via content distribution network to a cable head-end in response to the user selection (Fig. 8, col. 26, ll. 28-41).

As to **claim 20**, see claim 6 for similar rejection where the system is taught by the method.

As to **claim 21**, *Kelts* discloses a system to provide digital content to a content destination (Fig. 8, abstract), the system comprising:

means to provide a plurality content provider identifiers to a media terminal for display on an associated display device, wherein each content provider identifier is associated with a content provider (Fig. 1 col. 4, ll. 1-6 & col. 19, ll. 1-4, navigational interface featuring a set of symbols or icons representing service providers and broadcasting networks);

means to monitor user selection of one of the plurality of content provider identifiers (col. 22, ll. 7-11, presentation layer and navigation interface display within an end user's control can be monitored indirectly by a web browser application); and

means to communicate at least one available content identifier to the media terminal in response to the user selection of a content provider identifier, the available content identifier being associated with the content provider identifier (Fig. 1 col. 4, ll. 1-6, & col. 10, ll. 27-32, e.g. user can highlight a content provider identifier and a select button to view this channel).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 11, 12 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,139,983 B2 to *Kelts* in view of U.S. Patent No. 6,184,878 B1 to *Alonso et al.* ("*Alonso*").

As to **claim 11**, *Kelts* discloses the method of claim 10, which comprises: receiving digital content via a content distribution network at the cable head-end, the digital content being communicated using a TCP/IP format (col. 19, ll. 25-31); and

Kelts does not expressly disclose converting the digital content from the TCP/IP format to an MPEG format at the cable head-end.

Alonso discloses interactively accessing information from a computer network such as a TCP/IP network (*Alonso* Fig. 1 abstract) and converting digital content from the TCP/IP format to an MPEG format (*Alonso* Fig. 1, col. 3, ll. 19-23).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify *Kelts* by converting digital content from the TCP/IP format to an MPEG format as disclosed by *Alonso*. The suggestion/motivation would have been in order to transmit the audiovisual program in MPEG format through the cable network (*Alonso* Fig. 1, col. 3, ll. 19-23 & ll. 33-36).

As to **claim 12**, *Kelts* and *Alonso* in combination disclose the method of claim 11, wherein the converting is done on-the-fly (*Alonso* Fig. 1 abstract, col. 3, ll. 19-23).

As to **claim 19**, see claim 12 for similar rejection where the system is taught by the method.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KYU CHAE whose telephone number is (571)270-5696. The examiner can normally be reached on Mon-Thurs, 8 a.m - 4 p.m.; EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVEK SRIVASTAVA can be reached on (571)272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. C./
Examiner, Art Unit 2426

/VIVEK SRIVASTAVA/
Supervisory Patent Examiner, Art Unit 2426